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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,828	11/04/2003	Dan Kikinis	P1503D2	7049
23623 7590 05/08/2009 TUROCY & WATSON, LLP 127 Public Square 57th Floor, Key Tower CLEVELAND, OH 44114				
EXAMINER ELAHEE, MD S				
ART UNIT 2614		PAPER NUMBER		
NOTIFICATION DATE 05/08/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/701,828

Applicant(s)

KIKINIS, DAN

Examiner

MD S. ELAHEE

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-28 ans 30-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-28 ans 30-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date 02/27/2009
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/27/2009 has been entered.

Response to Arguments

2. Applicant's arguments mailed on 02/27/2009 Remarks have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time.

Claim Objections

3. Claims 17 and 22 are objected to because of the following informalities: regarding claim 17, the phrase "at least one of the at least one" in line 6 should apparently be "the at least one". Appropriate correction is required.

Claim 22 is objected to because of the following informalities: regarding claim 22, the phrase "and and" in lines 2-3 should apparently be "and". Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 17-24, 33, 36 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by **Lemaire et al.** (U.S. 5,444,768).

Regarding claim 17, with respect to Figures 1A and 2, **Lemaire** teaches an electronic document answering machine comprising:

an interconnected CPU 40, memory 15,54-58, and modem 42 with a telephone connection (col.8, lines 18-22);

Lemaire further teaches a system for rendering documents (fig.2; labels 13 and 20; col.7, lines 6-21, col.9, lines 18-31),

Lemaire further teaches an alert device for signaling that at least one new document is waiting to be reviewed (col.7, lines 6-21);

Lemaire further teaches an input device to signal rendering of at least one of the at least one new document (col.5, lines 36-66), and

Lemaire further teaches a digital port for connecting to a host personal computer (PC), wherein the electronic document answering machine periodically connects to at least one remote sources, receives and stores at least one digital document in the memory, and activates the alert device as a new document is stored, and wherein, in response to input device receiving an input, the electronic document answering machine renders stored documents, and whereto the electronic document answering machine is adapted to transmit stored documents to the PC for processing (fig. 4-5, fig.6, label 134,146; col.6, lines 55-65, col.14, lines 3-24).

Regarding claim 18, **Lemaire** teaches the electric document answering machine of claim 17 wherein the system for rendering stored documents comprises a speaker and voice synthesis apparatus (fig.4).

Regarding claim 19, **Lemaire** teaches the electronic document answering machine of claim 17 wherein the system for rendering stored documents comprises a display apparatus (col.9, lines 64-68).

Regarding claim 20, **Lemaire** teaches the electronic document answering machine of claim 17 adapted for use by the PC as a modem (fig.6, label 130).

Regarding claim 21, **Lemaire** teaches the electronic document answering machine of claim 17 wherein the modem is operated by the CPU and has no separate CPU (fig.6, label 130).

Regarding claim 22, **Lemaire** teaches the electronic document answering machine as in claim 17 wherein the at least one remote source includes an Internet mail server, and the at least

one new document includes at least one e-mail message addressed to a particular user (col.2, lines 40-45, col.3, lines 42-46, 60-63).

Regarding claim 23, **Lemaire** teaches the electronic document answering machine of claim 17 wherein the alert device includes at least one light emitting diode (LED) and the input is a pushbutton having the at least one LED integrated in the pushbutton (fig. 1A, labels 38,33).

Regarding claim 24, **Lemaire** teaches the electronic document answering machine of claim 23 further comprising a second pushbutton adapted for applying and removing power to power-using elements (fig. 1A, labels 30,32,34 or 36).

Regarding claims 33 and 36, with respect to Figures 1A and 2, **Lemaire** teaches a computing device, comprising:

a retriever that periodically accesses remote sources and retrieves and stores in memory at least one new digital document addressed to an addressee that is not already stored in memory of the computing device (fig. 4-5, fig.6, label 134,146; col.6, lines 55-65, col.14, lines 3-24); and

Lemaire further teaches an input device having at least one light emitting diode (LED) integrated in the input device, wherein the at least one LED signals that the at least one new digital document is stored in memory and ready for review, and wherein activation of the input device initiates rendering of the at least one new digital document (fig.1A, labels 38,33; col.5, lines 36-66, col.7, lines 6-21).

Regarding claim 37, **Lemaire** teaches the rendering includes rendering the at least one new digital document one-at-a-time (fig.1A, labels 38,33; col.5, lines 36-66).

6. Claims 30-32 are rejected under 35 U.S.C. 102(e) as being anticipated by **Cooper et al.** (U.S. 6,052,442).

Regarding claims 30, 31, with respect to Figures 1-3, **Cooper** teaches a computing device, comprising:

a memory for storing electronic documents having a delivery address (fig.6, label 106; col.1, lines 20-29, col.4, lines 37-43);

Cooper further at least one processor configured to access the electronic documents in the memory and periodically interface to at least one network store of electronic documents to receive a new set of electronic documents having the delivery address and to store the new set of electronic documents in the memory (col.1, lines 20-29, col.4, lines 37-43, 59-67);

Cooper further teaches an alert device that renders at least one of audio or video indicating receipt of the new set of electronic documents (fig. 2B, labels 25, 26; col.6, lines 19-29); and

Cooper further teaches an input device to request rendering of the electronic documents of the new set of electronic documents, and wherein the electronic documents stored in the memory are transferable to another computing device for processing (col.4, lines 43-47, col.7, lines 15-20).

Regarding claim 32, **Cooper** teaches that the transferring includes transferring to another computing device for display by said another computing device (col.8, lines 6-12).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 25-28, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lemaire et al.** (U.S. 5,444,768) in view of **Clark et al.** (U.S. 5,666,530).

Regarding claims 25, 34 and 35, with respect to Figures 1A and 2, **Lemaire** teaches an electronic document answering machine in a personal computer (PC), comprising:

a retriever for periodically accessing remote resources and retrieving and storing digital documents (fig. 4-5, fig.6, label 134,146; col.6, lines 55-65, col.14, lines 3-24);

Lemaire further teaches a light emitting diode (LED) alert apparatus for signaling a user that one or more new documents have been retrieved and stored and are ready for review (fig.1A, labels 38,33; col.7, lines 6-21); and

Lemaire further teaches an initializing input pushbutton having the LED alert apparatus integrated in the pushbutton to signal the system to initiate review of the stored documents (fig.1A, labels 38,33; col.5, lines 36-66),

However, **Lemaire** does not teach the following limitations:

“wherein the system is adapted to operate using CPU and memory elements of the PC with special operating code provided for the system, and to operate during periods of time the PC is in reduced-power power as well as when the PC is in full operating mode”

Clark teaches a computer which operates in full and power down capabilities (col.5, lines 24-37 and 65-col.6, line 15). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add power-down capabilities to **Lemaire’s** invention for providing reduced power consumption as taught by **Clark’s** invention in order to provide flexible operation capabilities.

Regarding claim 26, **Lemaire** teaches the system of claim 25 wherein the digital documents include e-mail (col.2, lines 40-45, col.3, lines 42-46, 60-63).

Regarding claim 27, **Lemaire** teaches the system of claim 25 where the LED alert apparatus and the pushbutton are in a keyboard in communication with the PC.

Regarding claim 28, **Lemaire** teaches the system of claim 27 wherein the LED alert apparatus is an LED in a standard keyboard adapted to serve as the alert apparatus, and the input apparatus is a standard key on the keyboard adapted to serve as the pushbutton (fig.1A, labels 38, 33).

10. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Cooper et al.** (U.S. 6,052,442) in view of **Perlman et al.** (U.S. 5,896,444) further in view of **Clark et al.** (U.S. 5,666,530).

Regarding claim 25, with respect to Figures 1 and 2, **Cooper** teaches an electronic document answering machine in a personal computer (PC), comprising:

a retriever for periodically accessing remote resources and retrieving and storing digital documents (col.1, lines 20-29, col.4, lines 37-43);

Cooper further teaches an alert apparatus for signaling a user that one or more new documents have been retrieved and stored and are ready for review (col.4, lines 41-43, col.4, lines 59-67); and

Cooper further teaches an initializing input for a user to signal the system to communicate the stored documents one-at-a-time for review by the user (col.4, lines 43-47, col.7, lines 15-20),

However, **Cooper** does not teach the following limitations:

“an LED alert apparatus” and “input pushbutton having the LED integrated in the pushbutton”

Perlman teaches an LED alert apparatus and input pushbutton having the LED integrated in the pushbutton (fig.1A, labels 38,33; col.5, lines 36-66). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add LED indicator to **Cooper**’s invention for providing alerting as taught by **Perlman**’s invention in order to provide visual notification.

Cooper in view of **Perlman** further does not teach the following limitations:

“wherein the system is adapted to operate using CPU and memory elements of the PC with special operating code provided for the system, and to operate during periods of time the PC is in reduced-power power as well as when the PC is in full operating mode”

Clark teaches a computer which operates in full and power down capabilities (col.5, lines 24-37 and 65-col.6, line 15). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add power-down capabilities to **Cooper**’s invention in view of **Perlman**’s invention for providing reduced power consumption as taught by **Clark**’s invention in order to provide flexible operation capabilities.

Regarding claim 26, **Cooper** teaches the system of claim 25 wherein the digital documents include e-mail addressed to the PC user (col.8, lines 6-12).

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MD S. ELAHEE whose telephone number is (571)272-7536. The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/MD S ELAHEE/
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Primary Examiner
Art Unit 2614
May 6, 2009